

REMARKS

I. Introduction

Claim 28 has been added. Claims 1 to 28 are currently pending in the present application. In view of the foregoing amendments and the following remarks, it is respectfully submitted that all of the presently pending claims are allowable, and reconsideration of the present application is respectfully requested.

II. Rejection of Claims 1 to 7, 12 to 23, and 25 to 27 Under 35 U.S.C. § 103(a)

Claims 1 to 6 were rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of U.S. Patent No. 5,268,140 (“Rutz et al.”) and U.S. Patent No. 5,122,255 (“Noda et al.”). It is respectfully submitted that the combination of Rutz et al. and Noda et al. does not render unpatentable claims 1 to 6 for the following reasons.

Claim 1 is related to a method for manufacturing a pressed part and, as herein amended without prejudice, recites a starting mixture that includes an iron powder and an auxiliary pressing agent, but that does not include a thermoplastic material. Support for the amendments to claim 1 may be found in the Specification, e.g., at page 1, lines 6 to 16; page 2, line 31 to page 3, line 23; page 3, line 34 to page 4, line 2; and page 5, lines 11 to 14. Rutz et al. refer to a mixture that includes thermoplastic material. Column 3, lines 6 to 11. The combination of Rutz et al. and Noda et al. does not disclose or suggest an advantageous starting mixture as recited in claim 1 that does not include a thermoplastic material. It is therefore respectfully submitted that the combination of Rutz et al. and Noda et al. does not render unpatentable claim 1.

Claims 2 to 6 ultimately depend from claim 1 and therefore include all the limitations of claim 1. Accordingly, without passing judgment on the merits of the Office Action's assertions regarding the limitations of claims 2 to 6, it is respectfully submitted that the combination of Rutz et al. and Noda et al. does not render unpatentable claims 2 to 6, by virtue of these claims' dependence on allowable claim 1. *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988) (any dependent claim that depends from a non-obvious independent claim is non-obvious).

Claim 7 was rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of Rutz et al., Noda et al., and U.S. Patent No. 6,383,281 (“Bayer”). It is respectfully submitted that the combination of Rutz et al., Noda et al., and Bayer does not render unpatentable claim 7 for the following reasons.

Claim 7 depends from and therefore includes all the limitations of claim 1. Accordingly, without passing judgment on the merits of the Office Action's assertions

regarding the limitations of claim 7, it is respectfully submitted that the combination of Rutz et al., Noda et al., and Bayer does not render unpatentable claim 7, by virtue of this claim's dependence on allowable claim 1. *Id.*

Claims 12 and 13 were rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of Rutz et al., Noda et al., and U.S. Patent No. 5,047,391 ("Bock et al."). It is respectfully submitted that the combination of Rutz et al., Noda et al., and Bock et al. does not render unpatentable claims 12 and 13 for the following reasons.

Claims 12 and 13 ultimately depend from and therefore include all of the limitations of claim 1. Accordingly, without passing judgment on the merits of the Office Action's assertions regarding the limitations of claims 12 and 13, it is respectfully submitted that the combination of Rutz et al., Noda et al., and Bock et al. does not render unpatentable claims 12 and 13, by virtue of these claims' dependence on allowable claim 1. *Id.*

Claims 14 to 23, 26, and 27 were rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of Rutz et al. and Bock et al. It is respectfully submitted that the combination of Rutz et al. and Bock et al. does not render unpatentable claims 14 to 23, 26, and 27 for the following reasons.

Claim 14 recites postforming a pressed part. As set forth in Applicants' Response, filed November 1, 2004, Bock et al. refer to grinding. While postforming by grinding is conceivable, grinding does not necessarily postform. Instead, by grinding a cast body, the body may be ground to individual powder particle particles and lose all form. While Bock et al. refer to grinding, nowhere do Bock et al. disclose or suggest that the performed grinding postforms a part. Nowhere do Bock et al. disclose or suggest postforming an annealed part. In the "Response to Arguments," the Office Action asserts that Bock et al., at column 2, lines 61 to 64, and column 3, lines 24 to 30, indicates grinding as postforming an annealed part. However, while these sections refer to intermediate grinding, nowhere do these sections indicate that the discussed grinding is a postforming operation. Indeed, Bock et al., at column 3, lines 15 to 19, and lines 24 to 30, refer to the production of a powder, not the production of a postformed pressed part formed from a mixture including a powder. It is therefore respectfully submitted that the combination of Rutz et al. and Bock et al. does not render unpatentable claim 14.

Claims 15 to 23, 26, and 27 ultimately depend from and therefore include all the limitations of claim 14. Accordingly, without passing judgment on the merits of the Office Action's assertions regarding the limitations of claims 15 to 23, 26, and 27, it is respectfully submitted that the combination of Rutz et al. and Bock et al. does not render

unpatentable claims 15 to 23, 26, and 27, by virtue of these claims' dependence on allowable claim 14. *In re Fine, supra*.

III. Allowable Subject Matter

Applicants note with appreciation the indication of allowable subject matter contained in claims 8 to 11, and 24. In this regard, the Examiner will note that claims 8 and 24 have been rewritten herein in independent form to include all of the limitations of their respective base claims. The Examiner will further note that claims 9 to 11 ultimately depend from claim 8. It is therefore respectfully submitted that claims 8 to 11, and 24 are in condition for immediate allowance.

IV. New Claim 28

New claim 28 has been added herein. It is respectfully submitted that new claim 28 does not add any new matter and is fully supported by the present application, including the Specification.

Since claim 28 depends from claim 14, it is respectfully submitted that claim 28 is patentable over the relied upon references for at least the same reasons set forth above in support of the patentability of claim 14.

V. Conclusion

In light of the foregoing, it is respectfully submitted that all of the presently pending claims are in condition for allowance. Prompt reconsideration and allowance of the present application are therefore earnestly solicited.

Respectfully submitted,

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